

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

CHA920030027US1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

10/798,508

Filed

03/11/2004

First Named Inventor

Farrett

Art Unit

2169

Examiner

Christopher J. Raab

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/65)

☒ attorney or agent of record.

Registration number 51,560

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Joseph J. Christian

Typed or printed name

(518) 449-0044

Telephone number

March 26, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:	10/798,508	Conf. No.:	6406
Applicant:	Farrett	TC/AU:	2169
Filed:	03/11/04	Examiner:	Raab, Christopher J.
		Docket:	CHA920030027US1 (IBM-0088)
Title:	SEARCH ENGINE PROVIDING MATCH AND ALTERNATIVE ANSWERS USING CUMULATIVE PROBABILITY VALUES (as amended)		

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant respectfully requests a panel of experienced examiners perform a detailed review of appealable issues for the above-identified patent application pursuant to the Pre-Appeal Brief Conference Pilot Program. Notice of Appeal has been filed together with this Request. Applicant submits that the above-identified application is not in condition for appeal because the Office has failed to establish proper rejections based on an error in fact and in law. Claims 1-15 are pending in this application.

Applicant notes well that the Advisory Action, dated February 28, 2007, had an incorrectly checked box. The box labeled "1.b)" should be checked instead of the box labeled "1.a)". This was due, in part, to Applicant submitted an After Final Amendment on January 3, 2007 which was filed within 2 months of the Final Rejection, due to the Day of Mourning recognized by the Office on January 2, 2007. As such, this brief is being submitted within one month of the Advisory Action, and therefore only requires a ONE-month extension fee. The Examiner confirmed this issue during telephone conversations with Applicant's representative.

Turning to the rejection, in the Final Office Action, dated October 31, 2006, claims 1-3, 6-9 and

11-13 are rejected under 35 U.S.C. §102(b) as allegedly being unpatentable over Bowman et al. (U.S. Patent No. 6,006,225), hereinafter “Bowman”. Claims 4-5, 10 and 14-15 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Bowman in view of Pak et al. (U.S. Patent Publication No. 2004/0260534), hereinafter “Pak”. Applicant submits that these rejections are clearly not proper and are without basis. Applicant submits that the application is not in condition for appeal because the rejections are defective due to errors in fact and in law.

Applicant also notes that in the Final Office Action, claims 1-5 and 10-15 were rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. In the After-Final Amendment, submitted on January 3, 2007, said claims were amended. As indicated in the Advisory Action, dated February 28, 2007, the After-Final Amendment was entered and the reply therein effective in overcoming the rejection under 35 U.S.C. §101. Hence, only the aforementioned rejections under 35 U.S.C. §102(b) (i.e., Bowman) and §103(a) (i.e., Bowman in view of Pak) remain from the Final Office Action.

As argued in the January 3, 2007 After-Final Amendment, at least one feature of the claimed invention is not taught by the reference. With respect to claim 1, Applicant submits the reference cited by the Office, Bowman, does not teach each and every feature of the claimed invention, as is required under 102(b). For example, with respect to independent claim 1, Applicant respectfully submits that the cited reference fails to teach, *inter alia*, inputting the look-up association into an **alternative answer** probability table to identify an **alternative answer category**, wherein the look-up association is determined based on the match answer **category** and a search history table. Emphasis added. See claim 1 and similar language in independent claims 6 and 11.

In rejecting claim 1, the Office alleges that Bowman discloses an inputting of the look-up association *et al.* as follows:

“[T]he generation process then maps each query term found in a query and its prefix to other terms used with that particular query. A correlation score is maintained for each related term in the mapping, and is stored in a table (read as determining a look-up association based on the match answer category and a search history table, inputting the look-up association into an alternative answer probability table to identify an alternative

answer category) (column 10 lines 25-33, figures 5A, 5B)”

Final Office Action, page 4, item 07. It appears that the Office is alleging that the sample mappings of both before and after a query, figures 5A and 5B, respectively in Bowman, are a teaching of an alternative answer probability table. Applicant respectfully does not agree that the citation aligns with the allegation. Clearly, there is no inputting of a look-up association into the mappings in figures 5A/5B in Bowman.

A careful reading of the cited sections (i.e., column 10, lines 25-33), figures 5A and 5B, and Bowman in its entirety, indicates that Bowman is completely devoid of any teaching or suggestion of any kind of an inputting of a determined look-up association into any type of a probability table, be it an alternative answer probability table or any kind of a probability table, as in the claimed invention. In fact, the salient portion of the specification in Bowman (i.e., col. 10, lines 25-33) merely discloses the maintenance of a “correlation score” for each related term in the mapping based on the number of times the related term occurred in combination with the key term. Further, it is not clear to Applicant which items in the mapping shown in figures 5A and 5B allegedly disclose specifically, for example, a match answer; a match answer category; a look-up association; a search history table; an alternative answer probability table; an alternative answer category; and/or an alternative answer. In sum, the Office’s allegation and citation cannot amount to meeting the requisite standard of showing a clear teaching of the aforementioned features.

Additionally, with respect to claim 1, Applicant respectfully submits that the cited reference also fails to teach, *inter alia*, performing a secondary search at a second random location in the knowledge base to find the alternative answer that **only** belongs to the alternative answer category, wherein the alternative answer category is identified via the inputting of the look-up association into an alternative answer probability table. Emphasis added. See claim 1 and similar language in independent claims 6 and 11.

In rejecting claim 1, the Office alleges that Bowman discloses these limitations as follows:

“[A]nd that successive searches are preformed on the modified query (read as performing a secondary search at a second random location in the knowledge base to find the alternative answer that only belongs to the alternative answer category) (column 13 lines 63 – 65, column 14 lines 1 – 12, Figure 5B, 9).”

Final Office Action, page 5, item 07. A careful reading of the cited sections and figures of Bowman does not show any teaching of the alleged limitations including any identifying of an alternative answer category via inputting, etc., and performing a secondary search to find the alternative answer that only belong to the alternative answer category. In fact, the cited section of Bowman (i.e., column 13, lines 63-65 and column 14, lines 1-12) merely discloses combining an original query term(s) with a respective related term. Bowman uses the example of entering the term “ROUGH” and three additional terms/hyperlinks of “ROUGH-GUIDE”, “ROUGH-LONDON”, and “ROUGH-TERRAIN”, are formed. Applicant respectfully submits that, similarly to the deficiency in the above limitation, it is not clear from the citation made by the Office what specifically in Bowman is a clear teaching, for example, of a secondary search; a second random location; an alternative answer; an alternative answer category; an alternative answer probability table; a look-up association; and/or an alternative answer that *only* belong to the alternative answer category. The Office’s allegation and citation cannot amount to meeting the requisite standard of showing a clear teaching of the aforementioned features.

Thus, Bowman does not teach all of the features found in claim 1. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to claim 1.

Independent claims 6 and 11 were rejected under the same rationale as claim 1. As a result, Applicant herein incorporates the arguments listed above with respect to claim 1.

With respect to dependent claims 2-5, 7-10 and 12-15 Applicant herein incorporates the arguments presented above with respect to the independent claims from which the claims depend. Further, Pak does not remedy the aforementioned deficiencies in Bowman. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features. Accordingly,

Applicant respectfully submits that without references that support the Office's allegation, the rejection is improper.

With respect to features in the dependent claims not specifically referenced herein, the dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

In view of the foregoing, Applicant respectfully submits that the rejection is defective, and the application is not in condition for appeal and should either be allowed as is, or re-opened for further prosecution. Should the examining panel believe that anything further is necessary to place the application in better condition for allowance or for appeal, they are requested to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,

/ Joseph J. Christian /

Joseph J. Christian
Reg. No. 51,560

Date: March 28, 2007

Hoffman, Warnick & D'Alessandro LLC
75 State Street, 14th Floor
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)